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IN THE

Supreme Court of the United States

OCTOBER TERM, 1969

No.

MOULTRIE MANUFACTURING COMPANY and
WILLIAM E. SMITH, *Petitioners*

v.

TENNESSEE FABRICATING COMPANY,
d/b/a TFC Co., *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Petitioners, Moultrie Manufacturing Co. and William E. Smith, pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit in this matter, entered on January 15, 1970. Mandate issued on February 5, 1970.

OPINIONS BELOW

The opinion of the District Court for the Middle District of Georgia, Thomasville Division, (Record, Vol. I, pp. 150-154), 159 USPQ 363, appears here attached as Appendix A. The opinion of the Court of Appeals for the Fifth Circuit (Record, Vol. II, p. 159), 164 USPQ 481, appears here attached as Appendix B.

JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1).

QUESTIONS PRESENTED

1. Whether, as the Court of Appeals for the Third Circuit has held in *Krafft* v. *Cohen,* 117 F.2d 579 (3rd Cir. 1941), certificate of copyright registration in the United States Copyright Office is "*not prima facie evidence* that the publication on the date therein stated bore the correct copyright notice, since the statute [17 U.S.C.A. 209] makes such certificate prima facie evidence only of the facts stated therein" or whether, as the Court of Appeals for the Fifth Circuit has held in the present case, ". . . the certificate of registration *is prima facie evidence* of the validity of the copyright, including the fact that the initial publication was with copyright notice." (Emphasis added.)

2. Whether photographic representations of Plaintiff's alleged copyrighted article, which appeared in Defendants' catalog constituted copyright infringement beyond Defendants' liability for actual reproduction of the articles themselves under 17 U.S.C. 101 or whether such photographic representations are within the doctrine of fair use for the purpose of advertising.

STATEMENT

Plaintiff, who is the registrant and owner of registration of claim to Copyright No. GP-26,299 relating to an architectural casting entitled "Nature" brought an action for copyright infringement, unfair trade practice and unfair competition in the United States District Court for the Middle District of Georgia, Thomasville Division. The District Court, however, rejected Plaintiff's contentions and found for the Defendants on all issues.

The architectural casting which was the subject of Plaintiff's alleged copyright was of aluminum, approximately one foot square and three-eighths of an inch thick having an open filigree pattern formed entirely of intercepting straight lines and arc lines.

At some time prior to September, 1962, Defendants came into possession of an architectural unit such as manufactured by Plaintiff and shown in their copyright Registration No. GP-26,299 and upon which there was no discernible copyright notice. However, subsequent to the institution of these proceedings, a surface covering of paint, which plaintiff alleged but never proved was put there by an unnamed third party, was removed from the unit and a copyright notice found beneath (TFC CO. ©).

From this architectural unit which had come into their possession, Defendants made a production match plate which was used to produce approximately 185 units, of which 64 were sold and 121 remained on display in Defendants' showroom.

At some time after September, 1962 Defendants, on being informed by telephone by the President of Plaintiff's corporation that Plaintiff claimed copyright in

the subject architectural unit and that Defendants were to cease to manufacture this unit, Defendants redesigned their unit by adding additional intercepting straight lines to the filigree pattern.

A photograph of an architectural unit (either one of Plaintiff's original or one of Defendants' copies) remained in the Defendants' catalog, but Defendants made no sales of such units. Inquirers were informed that the original article was not available through Defendants, but that Defendants offered a comparable unit of their own design. In August of 1964, however, Defendants were again contacted by Plaintiff through a letter from Plaintiff's attorney advising Defendants that he believed that Plaintiff's copyright was still being infringed. Defendants responded that they would no longer sell the product either in the original form nor in the redesigned form, and that any subsequent orders for the product would be forwarded to the Plaintiff. All subsequent inquiries relative to the product were forwarded to the Plaintiff. Plaintiff did not express any disapproval of this arrangement, nor of Defendants advertising the unit.

Subsequently, Plaintiff brought this action in the District Court, but introduced no evidence at the trial, nor did it introduce evidence tending to prove either that the initial publication or that all subsequent publications of the unit bore the requisite copyright notice. Plaintiff did introduce a single copy of its product which bore the copyright notice TFC CO.©, and a certified copy of this registration of the claimed copyright in the Copyright Office.

In finding for Petitioners-Defendants on all issues, the District Court held that publication with notice of copyright is required under Section 10 of the Copy-

right Law (17 U.S.C. 10), and that certificate of copyright registration *is not prima facie evidence* of publication with notice of copyright since publication is not a fact stated in the certificate of registration. Plaintiff, therefore, having no evidence of initial publication with copyright notice, had no basis upon which to claim copyright protection.

The District Court further found that the photographic representations which appeared in Defendants' catalog did not constitute copyright infringement and were within the doctrine of fair use for the purpose of advertising the subject architectural units.

In reversing the judgment of the District Court on all issues, the Court of Appeals for the Fifth Circuit held, however, that Plaintiff's certificate of registration was, "despite some authority to the contrary", prima facie evidence of publication with the necessary copyright notice and that the copyright was therefore valid. With respect to Defendants' photographic reproduction in catalogs of the architectural design, the Court of Appeals rejected the doctrine of fair use as applied by the District Court and held that the photographic reproductions by Defendants were, in addition to Defendants actual making of several of the design units, copyright infringements also, since "the sole purpose was to appropriate the Plaintiff's design."

REASONS FOR GRANTING THE WRIT

As heretofore noted, two issues are presented in this petition for review and it is urged that very substantial reasons exist in both cases for the granting of this writ.

First of all, as the Court of Appeals for the Fifth Circuit in this case has confirmed, there exists a direct

conflict between that Court and the Court of Appeals for the Third Circuit with respect to the vitally important question of the evidentiary effect of registration in the Copyright Office. The Third Circuit has held unequivocally in *Krafft* v. *Cohen,* (supra), that the certificate of registration *is not prima facie evidence* that publication on the date indicated in the registration bore correct copyright notice, whereas the Fifth Circuit Court of Appeals in the present case, while acknowledging the holding of the Third Circuit, has held that it is prima facie evidence that the initial publication was with proper copyright notice.

The resolution of this conflict between the respective Courts of Appeal in the Third and Fifth Circuits is vitally important and, therefore, a proper subject for review by the Supreme Court because of the great significance which proper notice at the time of publication has to the validity of claimed copyright and, in addition, because it is absolutely necessary that persons claiming copyright and registering their copyright with the Copyright Office know with certainty what effect their registration will have as provided by 17 U.S.C. 209.

It is to be borne in mind that the Federal statute requires (17 U.S.C. 10) that proper notice of copyright must be present on each copy when published or offered for sale in the United States and the Courts have repeatedly held that publication without such copyright notice forfeits any copyright interest to which the author might otherwise be entitled. *Bobbs-Merrill Co.* v. *Straus,* 210 U.S. 339 (1908), 52 L.E. 1086; *White* v. *Kimmell,* 193 F.2d 744 (9th Cir. 1952); *Clemens* v. *Belford,* 14 Fed. 728 (C.C.N.D. Ill. 1883); *Public Affairs Associates Inc.* v. *Rickover,* 284 F.2d 262 (D.C. Cir. 1960).

17 U.S.C. 209 provides that the certificate of copyright registration which the claimant of the copyright receives from the Copyright Office "shall be admitted in any Court as prima facie evidence of the facts stated therein." Nothing, however, in the certificate which the Copyright Office provides, states that proper copyright notice has been affixed to the work as originally published.

While there has been a division of authority on the question, other courts, in addition to the Third Circuit in *Krafft* v. *Cohen* (supra), have also interpreted the statute as providing that the certificate of registration of copyright does not prima facie establish the existence of necessary statutory notice of copyright at time of publication. *Harms Inc.* v. *Pure Milk Assn.*, 37 USPQ 575 (N.D. Ill. 1938); *Gray et al* v. *Eskimo Pie Corp.*, 244 F. Supp. 785 (D.C. Del. 1965).

The Fifth Circuit Court of Appeals has, however, taken the position, *despite the clear statement in the statute that the certificate of registration is prima facie evidence only of the facts stated therein,* that the certificate is also prima facie evidence of validity of the copyright because the Copyright Office has a rule requiring it to reject applications for copyright registration where the copyright notice does not meet the requirements of the law; and that, therefore, since registration is prima facie evidence of validity it must also be prima facie evidence of initial publication with proper copyright notice. Although Petitioners most strenuously disagree with this interpretation of the statute, it is urged that it is of the utmost importance to the proprietors of copyright and others who may be touched by this law that the conflicting interpretation by the respective Courts of Appeal and other Courts be resolved at this time.

The importance of the resolution of this conflict can be seen in the present case, where the Plaintiff was able to prevail on Appeal by merely relying, without further proof, upon its certificate of registration as being proof of critical facts (i.e., initial publication with proper copyright notice), which were not stated in the certificate of registration or the application therefor, thereby placing the heavy burden upon Defendants at the appeal stage of proceedings to establish that Plaintiff's initial publication was in fact without proper copyright notice. In fact, despite the fact that the architectural unit which Defendants obtained had no discernible copyright notice thereon, Plaintiff was required only to allege that an unnamed third party had obscured its notice to satisfy the Court of Appeals that it had complied with the statutory requisite of publication with notice.

The second reason why it is vitally necessary that the writ issue to review this case is that the Court of Appeals for the Fifth Circuit, in overruling the District Court, has extended Defendants' liability beyond the mere copying of a relatively small number of the structural units upon which Plaintiff asserted its claim of copyright to include, not only liability for copying these units, but also for the numerous photographic pictures which Defendants made and published in their catalog, thus potentially extending Defendants' liability manifold since statutory damages may now be awarded for each and every picture of the unit appearing in their catalog.

Petitioners have urged below and the District Court has agreed that the publication by Defendants in their catalog of pictures of the unit was a "fair use" and not an infringement of Plaintiff's copyright. In over-

turning the District Court, the Court of Appeals has, however, held that the doctrine of fair use has no application in this instance and that the "sole purpose was to appropriate the Plaintiff's design, either outright or by frivolous variation".

Admittedly, as the Court of Appeals has pointed out, the law of fair use as applied to copyright law is not inflexible but is to be determined by a number of factors including the nature and purpose of the work. It is pointed out, however, that, as the correspondence between Plaintiff and Defendants prior to the bringing of the suit in the District Court will attest, Defendants ceased to offer the pictured articles themselves for sale and referred all inquiries to Plaintiff, thus establishing that the pictures were in fact ultimately for the benefit of Plaintiff and not Defendants.

More importantly, however, than the injustice borne by Defendants is the fact that the Court of Appeals has here greatly extended by its decision the scope of copyright infringement to include copying in a completely unrelated media for an unrelated purpose having no direct bearing to the inherent design of the actual fabricated device, its use, or sale. Thus, the situation is to be distinguished from that in *Fleischer Studios, Inc.* v. *Ralph A. Freundlich, Inc.*, 73 F.2d 276, 23 USPQ 295 (2d Cir. 1934), where it was held to be infringement where characters depicted in a copyrighted cartoon strip were copied in a form of toys for sale. Here the infringer while copying in a different medium, was obviously relying for the sale of the toys on the characters which they inherently represented and which had been devised and copyrighted by the Plaintiff in his comic strip. Petitioners, however, have not attempted to sell pictures of the Plaintiff'

copyrighted unit or to trade, in these pictures, on the originality of the design of the article itself, but rather merely to advertise the device. Nor, in fact, did Defendants continue to show these pictures in their catalog for the purpose of selling the units themselves.

Thus, by holding that the photographic representations which Defendants published of the design unit are themselves infringement of Plaintiff's copyright, the Court of Appeals has dangerously extended the statutory meaning of copyright infringement to include the reproduction of the image of a device in a different medium even though there is no attempt to market the reproduced image or to trade on the inherent design of the device in the reproduction.

By this doctrine, any copying of a copyrighted article in different media, such as by photographs, becomes an infringement regardless of whether or not there is an attempt to trade, in the photographs, on inherent features of the article which gave rise to the copyright.

A newspaper photographer may now, for example, be liable for photographing a Congressman or other public official if, in doing so, he includes in the picture, which is subsequently published, his necktie which has a copyright design. Surely the Court should consider whether this substantial extension of the copyright law on infringement is to be countenanced.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF GEORGIA
THOMASVILLE DIVISION

TENNESSEE FABRICATING COMPANY, d/b/a TFC Co.,
Plaintiff,

v.

MOULTRIE MANUFACTURING COMPANY and WILLIAM E. SMITH,
Defendants.

Civil Action No. 785

ELLIOTT, District Judge:

This case came on for hearing on May 20, 1968. The transcript of the record being now available and the Court having had the benefit of briefs filed by counsel and having given consideration thereto, pursuant to the requirements of Rule 52 of the Federal Rules of Civil Procedure makes findings of fact and reaches conclusions of law as hereafter indicated.

FINDINGS OF FACT

1. This is an action for copyright infringement, unfair trade practices, and unfair competition.

2. The Plaintiff is the registrant and owner of Registration of claim to copyright No. GP-26,299 relating to an architectural casting entitled "Nature".

3. The architectural unit comprised an aluminum casting approximately one foot square and three-eighths of an inch thick having an open filigree pattern.

4. The filigree pattern is formed entirely of intercepting straight lines and are lines.

5. At some time prior to September, 1962 Defendant came into possession of an architectural unit such as manu-

factured by Plaintiff and shown in its copyright Registration No. GP-26,299. There was no discernible copyright notice on this unit; however, subsequent to the institution of these proceedings, a surface covering of paint was removed from the unit and a copyright notice found beneath (TFC CO. ©).

6. From the architectural unit which had come into its possession, Defendant made a production match plate which was used to produce approximately 185 units, of which 64 were sold and 121 remained on display in Defendant's showroom.

7. At some time after September, 1962 Defendant was informed by telephone by the President of Plaintiff corporation that Plaintiff claimed copyright in the subject architectural unit and that Defendant was to cease to manufacture this unit.

8. Defendant complied with Plaintiff's request and redesigned its unit by adding additional intercepting straight lines to the filigree pattern.

9. A photograph of an architectural unit (either one of Plaintiff's originals or one of Defendant's copies) remained in the Defendant's catalog; but Defendant made no sales of such units. Inquirers were informed that the original article was not available through Defendant, but that Defendant offered a comparable unit of its own design.

10. In August of 1964 Defendant was again contacted by Plaintiff through a letter from Plaintiff's attorney advising Defendant that he believed the Plaintiff's copyright was still being infringed. Defendant responded that it would no longer sell the product either in the original form nor in the redesigned form, and that any subsequent orders for the product would be forwarded to the Plaintiff. All subsequent inquiries relative to the product were forwarded to the Plaintiff. Plaintiff did not express any

disapproval of this arrangement, nor of Defendant's advertising the unit.

11. The Plaintiff introduced no evidence tending to prove that it had initially published its unit with copyright notice.

12. Plaintiff introduced no evidence tending to prove that all subsequent publications of the unit bore the requisite copyright notice. Plaintiff introduced a copy of Plaintiff's product which bore the copyright notice TFC CO.©.

13. Plaintiff is a corporation organized and existing under the laws of the State of Delaware. It is incorporated under the name Tennessee Fabricating Company and it is known in the industry by that name. There is no evidence to indicate that Plaintiff is widely known as TFC CO.

Conclusions of Law

1. Publication with notice of copyright is required under Section 10 of the Copyright Law (17 U.S.C. § 10); certificate of copyright registration is not prima facie evidence of publication with notice of copyright since publication is not a fact stated in the certificate of registration. Plaintiff, having no evidence of initial publication with copyright notice, has no basis upon which to claim copyright protection.

2. Plaintiff, having submitted no evidence that all copies of the work manufactured by it had borne copyright notice, cannot benefit from presumption that the copyright notice was obscured by some intervening third party. It must be presumed therefore that the architectural unit from which Defendant copied represents a publication with an obscure or indiscernible notice of copyright. Such a publication is a defense to copyright infringement claim.

3. The architectural unit which comprised the subject matter of Registration No. GP-26,299 does not possess the minimal degree of creativity required of a work of art. It is therefore not subject matter which warrants copyright protection and the Plaintiff's registration of claim to copyright is invalid.

4. The photographic representations which appeared in Defendant's catalog did not constitute copyright infringement and were within the doctrine of fair use for the purpose of advertising the subject architectural units.

5. The notation TFC CO. © which appeared on the copy of Plaintiff's work which was made of record is not adequate notice of copyright as required by the copyright law since TFC CO. is not the Plaintiff's name nor the name by which Plaintiff is known in the industry and the Plaintiff's full name does not appear elsewhere on the work.

Pursuant to the foregoing, judgment will be entered for the Defendants.

IT IS SO ORDERED this 15th day of August, 1968.

J. ROBERT ELLIOTT
United States District Judge

APPENDIX B

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 26880

TENNESSEE FABRICATING COMPANY, d/b/a TFC Co.,
Plaintiff-Appellant,

v.

MOULTRIE MANUFACTURING COMPANY and WILLIAM E. SMITH,
Defendants-Appellees.

Appeal from the United States District Court for the Middle District of Georgia

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(January 15, 1970)

Before RIVES, COLEMAN and MORGAN, Circuit Judges.

RIVES, Circuit Judge: This action for copyright infringement was heard before the court without a jury. Judge Elliott entered judgment for the defendants based upon succinct findings of fact and conclusions of law reported in 159 U.S.P.Q. 363.

Certificate of registration dated September 6, 1960, Class G. No. 26299 is a 12" x 12" architectural metal casting unit intended for use in combination or singly for a decorative screen or room divider to "finish up" a space. The judgment was based upon five different grounds which we have rearranged for convenience of discussion: (1) that the architectural unit does not possess the minimal degree of creativity required of a work of art; (2) that plaintiff

offered no evidence of initial publication with copyright notice; (3) that there was no evidence that all copies of the unit manufactured by the defendant bore the copyright notice; (4) that the notation "TFC Co. (c)" on the unit is not adequate notice of copyright; (5) that the photographic representations of the unit in defendant Moultrie's catalog did not constitute copyright infringement but were within the doctrine of "fair use." We do not agree with the district court on any one of the five grounds, nor on its further finding as to (6) whether the changes which defendants made in its revised design suffice to avoid infringing plaintiff's copyright. Answering that question in the negative, we reverse and remand for a determination of damages and entry of judgment enjoining further infringement and awarding damages to the plaintiff.

(1) *Creativity.*

The filigree pattern of the unit was formed entirely of intercepting straight lines and arc lines, but was original with the artist employed by plaintiff. It proved to be acceptable to architects, contractors and decorators and commercially successful. In 1962 the defendants came into possession of a copy of the unit on which the copyright notice had been obscured by paint. Using that unit as a mold the defendants made a pattern from the design and marketed the same. They also made a catalog and an advertising mat of the design and distributed them by mail and through their sales representatives.

Defendants' use of the design first came to the attention of plaintiff's president in a news release in the Flower & Garden Magazine of September 1962. He telephoned to defendant Smith, the president of the defendant Moultrie, "telling him that this was ours, and he [Smith] intimated that they would do nothing further, and that this would be dropped." The defendants redesigned their unit by adding four intercepting straight lines in the form of a diamond to the filigree pattern, and made no further sales of a unit

identical with plaintiff's. The defendants, however, continued to distribute the catalog and some 2 years later, August 24, 1964, plaintiff's counsel wrote a letter demanding the termination of the production of the design and payment of damages. Mr. Smith replied on August 26, stating that the design was being withdrawn from the new catalog which would be released in January or February of 1965, and that if any orders were received for the product they would be forwarded on to the plaintiff. The defendants, however, continued to use the old catalog until sometime in 1966 and the price list on the item until January 1, 1968. In the new catalog there were contained photographic representations of the design.

"In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form." Rules and Regulations of the Copyright Office, 17 U.S.C.A. 207 Rule 202.10(b); 37 C.F.R. § 202.10(b). "In order to be copyrightable, a work must contain at least a certain minimum amount of authorship in the form of original literary, artistic, or musical expression." Copyright Office Cir. 32. The circular lists as "common examples of uncopyrightable works": "time cards, report forms, graph paper, account books, diaries, checks, score cards, address books, order forms, vouchers, and the like." On the other hand, lack of artistic merit is no bar to copyright. *Rushton v. Vitole*, 2 Cir. 1955, 218 F.2d 434, 435. Compare 18 C.J.S. 169, Copyright and Literary Property § 26.

> "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' Originality in this context 'means little more than a prohibition of actual copying.' No matter how poor artistically the 'author's' addition, it is enough if it be his own. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250, 23 S.Ct. 298, 47 L.Ed. 460."

Alfred Bell & Co. v. *Catalda Fine Arts*, 2 Cir. 1951, 191 F.2d 99, 102-103.[1] That the filigree pattern on plaintiff's unit was designed by his artist is conceded. The defendants displayed a persistent desire to reproduce or capitalize on the unit. The language of Justice Holmes in *Bleistein* v. *Donaldson Lithographing Co.*, *supra*, is pertinent:

> "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights."

188 U.S. at 251, 252.

We hold that plaintiff's architectural unit possessed at least the minimal degree of creativity required for copyright.

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[1] *See also* Day-Brite Lighting, Inc. v. Sta-Brite Fluorescent Mfg. Co., 5 Cir. 1962, 308 F.2d 377, 386; H. M. Kolbe Co. v. Armgus Textile Co., 2 Cir. 1963, 315 F.2d 70, 72, 73; 18 Am.Jur. 2d 336; Copyright and Literary Property § 39.

(2) *Initial Copyright Notice.*

Initial publication with copyright notice is a prerequisite to a valid copyright. 17 U.S.C.A. 10. A rule requires the Copyright Office to reject an application for copyright registration when the copyright notice does not meet the requirements of the law. Sec. 202.2(b) of the Regulations of the Copyright Office; 17 U.S.C.A. 207, Rule 202.2(b); 37 C.F.R. § 202.2(b). The certificate of registration "shall be admitted in any court as prima facie evidence of the facts stated therein." 17 U.S.C.A. 209. The pertinent certificate of registration shows "6 (a) Date of Publication: 1st April, 1960." Despite some authority to the contrary,[2] the better rule and that sustained by the weight of authority is that the certificate of registration is prima facie evidence of the validity of the copyright, including the fact that the initial publication was with copyright notice.[3]

(3) *Subsequent Copyright Notices.*

The plaintiff did not have the heavy burden of proving that *all* publications were with copyright notice; instead, the burden rested on the defendants to establish invalidation of the copyright.[4]

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[2] *See* Harms, Inc. v. Pure Milk Ass'n, N.D. Ill. 1938, 37 U.S.P.Q. 575; Nimmer on Copyright § 139.2.

[3] Gerlach-Barklow Corp. v. Morris & Bendien, 2 Cir. 1927, 23 F.2d 159, 162; Stuff v. E.C. Publications, Inc., 2 Cir. 1965, 342 F.2d 143, 144, *cert. denied*, 382 U.S. 822; Whitol v. Wells, 7 Cir. 1956, 231 F.2d 550, 553; Flick-Reedy Corp. v. Hydro-line Mfg. Co., 7 Cir. 1965, 351 F.2d 546, 549, *cert. denied*, 383 U.S. 958; Bohauer v. Friedman, 9 Cir. 1962, 306 F.2d 933, 935. Compare Hirshon v. United Artists Corp., D.C. Cir. 1957, 243 F.2d 640, 644; 18 Am.Jur. 2d Copyright and Literary Property, § 151; 18 C.J.S. Copyright and Literary Property, § 154.

[4] *See* Nimmer on Copyright § 139.2; Comment, *Copyright Notice Requirements*, 59 Mich. L. Rev. 616 (1961). *See also* authorities cited in note 3, *supra*. Actually there is little doubt that the copyright notice appeared on the initial publication and all subsequent

(4) *Adequacy of Notice of Copyright.*

The district court held that

> "The notation TFC Co. (c) which appeared on the copy of Plaintiff's work which was made of record is not adequate notice of copyright as required by the copyright law since TFC Co. is not the Plaintiff's name nor the name by which Plaintiff is known in the industry and the Plaintiff's full name does not appear elsewhere on the work."

We do not agree with the district court's literal application of 17 U.S.C.A. 19 to the facts of this case. The Certificate of Registration of the copyright listed the name of the claimant as "Tennessee Fabricating Company d/b/a TFC Co." Abe Sauer, plaintiff's president, testified without contradiction:

> "Q. Does Tennessee Fabricating Company do business as TFC Company?
>
> "A. It does. That is our trade-mark and standard name registered with the Federal Government as a trade-mark."

All of plaintiff's advertising in evidence bore the abbreviation. We agree with the holding of then Chief District Judge Dyer in *Key West Hand Print Fabrics, Inc.* v. *Serbin, Inc.*, S.D.Fla. 1966, 269 F.Supp. 605, 611, that "indeed, it is not necessary that the owner's true name be used at all so long as a name with which it is identified is used and no innocent persons are mislead." *Affirmed per curiam, Serbin, Inc.* v. *Key West Hand Print Fabrics, Inc.*, 5 Cir. 1967, 381 F.2d 735. *See also Dan Kasoff, Inc.* v. *Gresco Jewelry Co.*, S.D.N.Y. 1962, 204 F.Supp. 694, *aff'd* 308 F.2d 806 (2 Cir. 1962); *Doran* v. *Sunset House Dis-*

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publications. Three identical copies are disclosed by the record all from the same casting process as the original. Compare Florence Art. Co., Inc. v. Quartite Creative Corp., D.C. N.D. Ill. 1968, 158 U.S.P.Q. 382.

tributing Co., S.D. Calif. 1961, 197 F.Supp. 940, *aff'd*, 304 F.2d 251 (9 Cir. 1962); Nimmer on Copyright § 314; 18 Am. Jur. 2d Copyright and Literary Property, § 62; 18 C.J.S. Copyright and Literary Property, § 71, p. 195, notes 76 and 79.

(5) *Fair Use.*

The district court held:

> "The photographic representations which appeared in Defendants' catalog did not constitute copyright infringement and were within the doctrine of fair use for the purpose of advertising the subject architectural units."

The concept of "fair use" is admirably explained by John Schulman in an article in the Iowa Law Review:

> "The doctrine of 'fair use,' as a balance wheel and safety valve for the copyright system, was promulgated more than one hundred thirty years ago, as a judicial rule of public policy.[1] . . .
>
> "The authorities are in agreement that the line of demarcation between 'fair use' and copyright infringement cannot be determined by resort to any arbitrary rules or fixed criteria. In each situation, the decision depends on an examination of a variety factors which include:[3]
>
> "1. The nature and purpose of the respective works;

"[1] Folsom v. Marsh, 9 F. Cas. 342, 343 (C.C.D. Mass. 1841).
. . .

"[3] *See* Folsom v. Marsh, 9 F. Cas. 342, 343 (C.C.D. Mass. 1841); M. Nimmer, Copyright § 145 (1963); H. Howell, Copyright Law 151-54 (A. Latman ed. 1962); Schulman, *The Copyright Law—Is It a Roadblock to Information Retrieval?*, 11 Bull. Copy. Soc'y 369, 375 (1964); Yankwich, *What Is Fair Use?*, 22 U. Chi. L. Rev. 203, 212 (1954)."
53 Iowa Law Review 832, 833.

"2. The quantity and importance of the portions taken;

"3. The relation of the portions used to the respective works of which they are a part;

"4. The impact of the use of these portions upon the demand for the copyrighted publication.

"This flexibility in the concept necessarily flows from the fact that the 'fair use' privilege is predicated upon good faith and fair dealing. It serves the purpose of maintaining a proper balance between the exclusive rights secured to authors under the Copyright Statute, and the correlative right of the public to benefit from those contributions to literature, science, and the arts for which protection is provided for authors and other creators. . . ."

The topic of "fair use" is fully and ably discussed by Judge Leonard Moore in *Rosemont Enterprises, Inc.* v. *Random House, Inc.*, 2 Cir. 1966, 366 F.2d 306-310, *cert. denied*, 385 U.S. 1009 (1967). *See also* 18 Am. Jur. 2d Copyright and Literary Property § 109; 18 C.J.S. Copyright and Literary Property § 94(4). All of the authorities agree that to constitute "fair use" the permitted use must be for some legitimate, fair and reasonable purpose. The defendants' sole purpose was to appropriate the plaintiff's design either outright or by frivolous variation. The doctrine of fair use has no application to the conduct of the defendants.

(6) *Defendants' Redesigned Unit.*

The district court found that the defendants complied with plaintiff's request to cease to manufacture its unit "and redesigned its unit by adding additional intercepting straight lines to the filigree pattern." The defendants concede, as they must, that the starting for their "redesign" was the plaintiff's work. Infringement is not confined to

exact reproduction but includes colorable alterations made to disguise the piracy. *Gross* v. *Seligman*, 2 Cir. 1914, 212 F.2d 930; 18 C.J.S. Copyright and Literary Property § 94 c, p. 217. We have no doubt that defendant's "redesign" infringed plaintiff's copyright.

For the reasons stated, the judgment is reversed and the cause remanded for a determination of damages[5] and entry of a judgment enjoining further infringement and awarding damages.

REVERSED AND REMANDED.

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[5] The plaintiff undertook to waive actual damages and relies solely upon statutory "just" damages. *See* 17 U.S.C.A. 101; Key West Hand Print Fabrics, Inc. v. Serbin, Inc., *supra*, 269 F.Supp. at 615.

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IN THE

SUPREME COURT of the UNITED STATES

OCTOBER TERM, 1969

No. 1410

MOULTRIE MANUFACTURING COMPANY and WILLIAM E. SMITH, *Petitioners*

v.

TENNESSEE FABRICATING COMPANY, d/b/a TFC Co., *Respondent*

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

I.

The decisions of the courts which have considered the first question, to-wit:

> Is Respondent's Certificate of Copyright Registration prima facie evidence of copyright?.

are unanimously in accord with the decision of the Circuit Court.

In cases cited in support of the Petition, the Courts did not rule contrary to the ruling of the Court of Appeals. In the case of *Krafft v. Cohen*. 117 F 2d 578 (3d Circ., 1941), there was proof of plaintiff's publication with an improper notice, in that the notice was in the wrong place and lacked the name of the proprietor. This proof rebuted the *prima facie* case established by the Certificate. Any other language of the Court on this issue was merely *dictum*. The true holding of the *Krafft* decision is that

> "[T]he deliberate selection and use of a certain form of Copyright notice, which fails to meet the substantive requirements [of the Copyright law], can hardly be termed 'omission by accident or mistake of the prescribed notice from a particular copy or copies.' " *Advertisers Exchange v. Anderson*, 144 F 2d 907 (8th Circ., 1944).

It is interesting to note that in all other cases on the issue arising within the Third Circuit, the District Courts have unanimously felt free of the restraints alleged by petitioners to be contained in the *Krafft* case. See *Berlin v. Evans*. 300 F. 677 (D.C., E.D., Pa., 1924); *Dietrich v. Standard Brands, Inc.*, 32 F. R. D. 325, 326 (D.C., E.D., Pa., 1963); *Hedeman Products Corp. v. Tap-Rite Products Corp.*, 228 F. Supp. 630, 633 (D.C., D. N.J., 1964); *Magnus Organ Corp. v. Magnus*, 269 F. Supp. 981 (D.C., N.J., 1967).

In *Gray v. Eskimo Pie Corp.*, 244 F Supp. 785 (D.C., Del. 1965) proof was introduced to show publication was made without any notice at all. The single ruling to the contrary, *Harms, Inc. v. Pure Milk Ass'n.*, 37 U.S.P.Q. 575 (N.D., Ill., 1938), has been effectively overruled by the decision in the case of *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F 2d 546 (7th Circ., 1965), *Cert.* denied 383 U.S. 958.

The rationale of these cases is that defendant's proof of nonexistent notice, can controvert the *prima facie* case made out by plaintiff's certificate of copyright.

The Circuit Courts of Appeal for the Second Circuit *Gerlach-Barlow Corp. v. Morris & Bendien*, 23 F 2d 159 (1927); *Modern Aids, Inc., v. R. H. Macy*, 264 F 2d 93 (1959); the

Seventh Circuit *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F 2d 546 (1965)); the Ninth Circuit *Rohauer v. Friedman* 306 F 2d 933 (1962)); and the Fifth Circuit (in the case sought to be reviewed, *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F 2d 279 (1970)), are all in accord. There is no dissent.

Prior to the 1909 Copyright Act, requirements for perfecting copyrights were strictly construed. *Wheaton & Donaldson v. Peters & Grigg*, 11 U.S. 223 (1834); *Callaghan v. Myers* 128 U.S. 617 (1888). The United States Supreme Court, however, in *Washingtonian Co. v. Pearson*, 306 U.S. 30, 36, (1938), said:

> "The Act of 1909 is a complete revision of the copyright laws, different from the earlier Act both in scheme and language. It introduced many changes and was intended definitely to grant valuable, enforceable rights to authors, publishers, etc., without burdensome requirements; 'to afford greater encouragement to the production of literary works of lasting benefit to the world.' "

The liberal spirit of construction, as stated in the *Pearson* decision, should control copyright decisions; and invalidation of a copyright should not be lightly undertaken. *Hirshan v. United Artist Corp.*, 243 F 2d 640, 644 (D. C. Circ., 1957)

The Court may take judicial notice of the fact "that the Examining Division of the Copyright Office, among other things, checks for the adequacy of notice of copyright on works submitted." *Ross Products, Inc. v. New York Merchandise Co.*, 242 F Supp. 879, 880 (D.C., S.D., N.Y., 1965). Section 202.2(b) of the Regulations of the Copyright Office States:

> *Defects in notice*. Where the copyright notice does not meet the requirements of the law, the Copyright Office will reject an application for copyright registration. ***"

The Copyright Office, therefore, had to be satisfied that the copies it received had the proper notice (Exhibit I).

That the notice was included in the copies deposited is, therefore, included within the certificate of copyright. The proper including of the notice of copyright is a "fact stated therein." [i.e., in the certificate, as " *prima facie* evidence," as set forth in Section 209 of the Copyright Act.]

II.

Petitioners' second question, for which review is sought, is, in essence, two issues, and respondent will so treat it.

A. The first portion is:
Does a two-dimensional photograph infringe a copyright protecting a three-dimensional work of art?

The infringement by way of using a picture of the copyrighted design in petitioners' catalogue and in petitioners' advertising material is no less an infringement than the manufacturing of the infringing design units themselves, i.e., the difference in the mode of adaption or expression chosen to infringe cannot be set up as a defense. *Mazer v. Stein*, 347 U.S. 201, 218 (1953); *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911); *Universal Pictures Co. v. Harold Lloyd Co.*, 162 F 2d 354, 360 (9th Circ., 1957); the following cases had facts identical to the case at bar *Bracken v. Rosenthal*, 151 Fed. 136 (N.D., Ill., 1907) (Photograph of bas-relief statue infringed copyright protecting statue); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F 2d 99, 105 (2d Circ., 1951) (Reproductions of copyrighted painting print in catalogues of defendant infringes copyrights protecting print.) *King Features, Inc. v. Fleischer*, 299 Fed. 533 (2d Circ., 1924); *Fleischer Studios v. Freundlich* 73 F 2d 276 (2d Circ., 1934); (3-dimensional doll infringed copyright on 2-dimensional cartoon); *M. J. Golden & Co., Inc. v. Pittsburgh Brewing Co., Inc.* 137 F Supp. 455 (D. C.. Pa., 1956) (2-dimensional copy infringed plaintiff's copyright on 3-dimensional plaque). *Mura v. Columbia Broadcasting Systems, Inc.*, 245 F Supp. 5 (S.D., N.Y., 1965) (Copyright of puppet infringed by picture. but other defenses allowed defendant to prevail). The *Bracken*, *M. J. Golden* and *Mura* cases are particularly in point, each involving a 2-dimensional pirating of a 3-dimensional work; and each holding that infringement occurred.

The Courts in the case of *Scherr v. Universal Match Corp.*, 160 U.S.P.Q. 216, 297 F. Supp. 107 (D.C., S.D., N.Y., 1967) affirmed, 417 F 2d 497 (2d Circ., 1969) assumed that a photograph (in that case, printed on match covers) was infringement of a copyright protecting a large statue. (There were other issues in that case which caused the Courts to hold the copyright invalid).

The early case of *Falk v. T. P. Howell & Co.*, 37 Fed. 202 (C.C., S.D., N.Y., 1888), holding that stamping a picture in leather infringed the copyright protecting the photograph embodying the picture, was cited with approval in the recent case of *Geisel v. Poynter Products, Inc.*, 295 F. Supp. 331, 350, (D.C., S.D., N.Y., 1968), a case involving the transformation of a comic-strip character into a doll.

Respondent can find no authority to the contrary, and petitioners cite none.

B. The second phase of Petitioners' second question is:

Was petitioners' use of the catalogue within the doctrine of "Fair Use?"

The latest and most complete discussion of the topic of "fair use" is contained in the opinion in *Rosemont Enterprises, Inc. v. Random House, Inc.*, 306, F 2d 303, 306-310 (2d Circ., 1966). *Cert.* Denied 385 U.S. 1009. The Court there stated (at page 307) that,

> "Whether the privileges [of using copyrighted material without the author's permission] may justifiably be applied to particular material turns initially on the nature of the materials, e.g., whether their [the infringing] distribution would serve the public interest in the free dissemination of information and whether their preparation requires some use of prior materials dealing with the same subject matter***."

See also Yankwich, "What is Fair Use?" 22 U. CHI. L. REV. 203, 213-215 (1945); Schulman, "Fair Use and Revision of the Copyright Act." 53 IA. L. REV. 832 (1968).

This not the case of petitioners' making a contribution to human progress, utilizing, as part of an independent research, Respondent's design unit. It was a wholesale piracy. Respondents must do *something* of their own to obtain the benefits of the doctrine of "fair use." *Rosemont* opinion, *supra* at 310.

Petitioners' sales catalogues contained photographs of Respondent's work of art. Some editions had words of description accompanying the photographs, and other had the photographs only. Petitioners admit that the inescapable conclusion to readers of these sales catalogues would be that the work of art was available for purchase from the Petitioners.

Petitioners ask this Honorable Court to determine that a sales catalogue is not a sales catalogue; and, that if it is a sales catalogue, its purpose is not that of making sales.

III.

CONCLUSION

For the foregoing reasons, the petition for a Writ of Certiorari should be denied.

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